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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,693	07/24/2003	John F. Meyer	10981437-3	9441

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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10/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/626,693

Applicant(s)

MEYER, JOHN F.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 18-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 18-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

I. Applicant's arguments filed on July 17, 2007 have been fully considered but they are not persuasive.

a. Applicant remarks that, first, Kenmochi et al appears to require a personal computer (a DTE connected to a DTE interface unit) to operate in fax send, scan and print modes and those modes require special codes to operate the apparatus. Second, Kenmochi et al cannot operate without receiving the special commands from some external unit, such as the personal computer. Third, the destination fax numbers are specifically stated as coming from the external unit, namely the personal computer. There is no allowance in Kenmochi et al for entering destination fax numbers other than through the personal computers.

Kenmochi et al discloses in Fig.1 an image communication apparatus, which can transmit and receive photograph or other image to be printed on a fixed medium as claimed. In Fig.18, Kenmochi et al discloses a digital camera with a camera control 910 for taking pictures, a PCMCIA memory card 918 for storing the pictures. Kenmochi et al further teaches, "In order to transmit or store image picked up by the digital camera and stored in the PCMCIA memory card 919, the PCMCIA memory card 919 is inserted into the PCMCIA interface 1-18 shown in Fig 1. The communication apparatus is able to print the image picked up and stored in the memory card 919 and transmit the image data through the line according to the commands from the operation unit 1-4... In addition, only one image to be selected can be printed and facsimile-transmitted

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according to the commands of the operation unit 1-4, or all images or the compressed index images of all images can be printed and facsimile-transmitted according to a software.” (col. 11, lines 33-62). Thus, the communication apparatus (Fig.1) does not need to be connected to the DTE or computers in order to transmit or receive a photograph or other images. In addition, in Figs. 16 and 17, the communication apparatus is in place of the “DTE” shown in Figs.3 and 5, and the PCMCIA modem card is in place of the communication apparatus shown in Figs. 3 and 5. The operation is almost similar to that in Fig.3 (col. 10, lines 42-47). The PCMCIA modem card is higher in performance than the built-in modem 1-8 in the communication apparatus, that is, for example, capable of simultaneously transmitting and receiving audio data and image data. Besides, Kenmochi et al teaches an operation unit 1-4 for as a data entry element on a hand-accessible surface for entering a destination fax for signals representing an image, and a hand-set unit 1-20 connected to the NCU unit 1-9 for transmitting and receiving of the audio and image data. Thus, in Kenmochi et al, there is allowance for entering destination fax or telephone for signals representing an image as claimed.

b. Applicant argues that Bowden does not show a cabinet or a housing for the combination. Even though Bowden refers to the assembly as a wall-mounted cabinet, the structure is not a cabinet, which is a structure resembling a cupboard with doors, shelves and drawers. The pay telephone and the copier and facsimile in Bowden have their own separate housings, and cannot share any common housing.

It is noted that the features upon which applicant relies (i.e., a cabinet) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations

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from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, the claims must be given their broadest reasonable interpretation. During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. In *re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541m 550-51 (CCPA 1969). It is noted that a "housing" is mostly claimed in the claims and even the drawings illustrating the recent invention do not shown the detailed limitations remarked by the applicant (a cabinet with doors, shelves, drawers, etc.).

Moreover, previously cited reference, Ishiwatari et al (US Patent No. 5,283,820) is from the same field of endeavor of a housing with a fax phone using memory card to transmit image data (Figs.1 and 10).

Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Thus, the rejection of the claims is maintained with some modification due to the amendment of the claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 18-39, 42-48, 62, 66-78 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenmochi et al (US Patent No. 5,900,947) in view of Bowden (US Patent No. Des. 390,225).

Concerning claims 1, 18, 19, 20, 26, 27, 31, 32, 33, 34, 36, 42, 43, 44, 45, 47, 48, 66, 72-76, and 81, Kenmochi et al discloses an apparatus or device (Fig.1) for sending and receiving a photograph or other image to be printed on a fixed medium comprising a housing, a data entry element on a hand-accessible surface of the housing for entering a destination for signals representing an image (1-4); a paper cartridge or a paper storage for holding paper to be output from the opening (1-6); a connection adjacent the housing for receiving data from a camera storage element (1-18); a memory for storing signals representing an image (1-3); an interface jack between the housing and a communication line (1-9); conversion means for converting signals representing an image into data for controlling a printer for printing an image onto the paper (1-15); means for transmitting signals from and receiving signals in the housing representing images (1-9); an indicator for indicating that digital images are stored and ready for printing (1-1, 1-4); a connection for receiving JPEG data from a camera storage element (1-18); a printer (1-6) for printing an image onto the paper larger than six inches wide (since it can print

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image on a regular paper size); wherein the apparatus omits any lens for receiving light representing an image to be recorded (when receiving image data from the memory card, communication line), and the receiving and sending means includes a color fax modem (1-8); the interface jack (1-9) is configured to connect to a telephone line (1-10, 1-11), (Figs.13-17; Abstract; col. 2, line 52 – col. 4, line 8; col. 10, line 15 – col. 11, line 62).

It is noted that the communication apparatus (Fig.1) does not need to be connected to the DTE or computers in order to transmit or receive a photograph or other images. In addition, in Figs. 16 and 17, the communication apparatus is in place of the “DTE” shown in Figs.3 and 5, and the PCMCIA modem card is in place of the communication apparatus shown in Figs. 3 and 5. The operation is almost similar to that in Fig.3 (col. 10, lines 42-47). The PCMCIA modem card is higher in performance than the built-in modem 1-8 in the communication apparatus, that is, for example, capable of simultaneously transmitting and receiving audio data and image data. Besides, Kenmochi et al teaches an operation unit 1-4 for as a data entry element on a hand-accessible surface for entering a destination fax for signals representing an image, and a hand-set unit 1-20 connected to the NCU unit 1-9 for transmitting and receiving of the audio and image data. Thus, in Kenmochi et al, there is allowance for entering destination fax or telephone for signals representing an image as claimed.

Kenmochi et al fails to teach a housing, a wall defining an output for printing a medium on which is fixed a photo image, a removable means for removable holding a plurality of sheets of the medium, a paper cartridge and the connection is mounted in a wall in the housing. However, it was a matter of well-known in the prior art to have all of these limitations in Kenmochi et al system since any conventional fax with a printer can have them. Bowden

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discloses a communication center combining a copier, facsimile and telephone in a wall mounted cabined (Figs.1-2) with a wall defining an output for printing a medium, a removable holding tray for holding a plurality sheets and a paper cartridge for printing. It would have been obvious to one skilled in the prior art at the time the invention was made to combine the above teaching in Bowden, as a matter of well-known in the art to the system in Kenmochi since Kenmochi also teaches a recording unit with a jet printer unit, a paper feed roller, general purpose integrated circuits, fetches the data stored in the RAM 1-3 and prints out the data as hard copies, a sensor 1-12 with a recording paper width sensor, a recording paper presence sensor, a original width sensor and an original sensor, for detecting the condition of the original and recording paper which indirectly teaches the above limitations of the printing device.

Concerning claims 21-25, 28-30, 35, 37, 38, 39, 46, 66, 67, 68, 69, 70, 71, 77 and 78, Kenmochi further teaches a memory for storing signals representing an image (1-3), (claims 21, 51, 67); an interface for transmitting signals from and receiving signals representing images (1-9), (claims 22, 38, 46, 52, 62, 68, 77); a conversion means for converting signal representing image into data for controlling a printer for printing an image onto the paper (1-15), (claims 23, 53); a printer (1-6), (claims 24, 69, 78); a feed mechanism for feeding the paper from the storage to the printer (1-7), (claims 25, 55); a color printer (1-6), (claims 27, 54); the printer is sized to accept paper larger than six inches wide (col. 3, lines 26-30), (claims 28); a handset for voice communication (1-20), (claims 29, 58); a display for providing information to a user (1-4), (claims 30); the JPEG data can be received from outside the system (1-9, 1-18), (claims 35, 59); the connection is adapted for receiving a camera memory module (1-18, Fig.1, 919, Fig.18),

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(claims 37, 61); means for receiving and sending digital image files (1-9, 1-17, 1-18), (claims 56, 70); a color fax modem (1-8), (claim 57)

3. Claims 49-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenmochi et al (US Patent No. 5,900,947) in view of Bowden (US Patent No. Des. 390,225) and Axten et al (US Patent No. 5,250,986)

Concerning claims 49, 50, 60, 65, Kenmochi et al in view of Bowden discloses the apparatus discussed in claim 1 above.

Kenmochi et al fails to teach an indicator for producing light and for indicating that the images are stored and ready for printing. However, it was commonly known in the art for a printer or a facsimile apparatus with a printing device to have an indicator for indicating the state of ready for printing of the printer. Axten et al supports that well-known in the prior art by disclosing a facsimile with a printer or a printer with a plurality of different light indicators 22-28 on a control panel 12 for indicating the status or condition of the printer such as feed indicator 26 shows the status of data in the printer, if it is ON, printer 10 has printable data, if it is flashing, the printer is in a manual feed state. Moreover, ready indicator 28 is used to signal the ready status of the printer. If it is ON, the printer is ready (it can receive data), if it is blinking, the printer is ready and either processing data or printing data (col. 2, line 47 – col. 3, line 13). It would have been obvious to one skilled in the prior art at the time the invention was made to combine the above teaching in Bowden, as a matter of well-known in the art to the system in Kenmochi since Kenmochi indirectly teaches a sensor 1-12, a buzzer unit 1-14 and a driving unit 1-7 for indicating that the images are stored and ready for printing.

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Concerning claims 51, 52, 53, 54, 55, 56, 57, 58, 59, 61, 62, Kenmochi further teaches a memory for storing signals representing an image (1-3), (claim 51); an interface for transmitting signals from and receiving signals representing images (1-9), (claim 52); a conversion means for converting signal representing image into data for controlling a printer for printing an image onto the paper (1-15), (claim 53); a feed mechanism for feeding the paper from the storage to the printer (1-7), (claim 55); a color printer (1-6), (claim 54); a handset for voice communication (1-20), (claim 58); the JPEG data can be received from outside the system (1-9, 1-18), (claim 59); the connection is adapted for receiving a camera memory module (1-18, Fig.1, 919, Fig.18), (claim 61); means for receiving and sending digital image files (1-9, 1-17, 1-18), (claim 56); a color fax modem (1-8), (claim 57); an interface for transmitting from and receiving into the housing fax communication signals representing images (1-17, 1-18, 1-10, Fig.1), (claim 62).

4. Claims 40, 63 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenmochi et al in view of Bowden and Axten et al as applied to claims 1, 20, 35, 36, 60 above, and further in view of Hassan (US Patent No. 5,550,646).

Concerning claims 40, 63 and 79 Kenmochi et al in view of Bowden fails to teach that the connection is adapted for receiving a cable from a digital camera. Hassan discloses a system with a camera 110 connected to a facsimile machine 140 through a cable for receiving images transferred from the camera (Fig.1). It would have been obvious to one skilled in the prior art at the time the invention was made to combine the above teaching of Hassan to the system in Kenmochi since Kenmochi also teaches different connections (1-9, 1-17, Fig.1) adapted for receiving a cable from different apparatus not limit to a camera.

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5. Claims 41, 64 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenmochi et al in view of Bowden and Axten et al as applied to claims 20, 35, 49, 59 and 66 above, and further in view of Yamakita (US Patent No. 6,366,698).

Concerning claims 41, 64 and 80, Kenmochi et al in view of Bowden fails to teach that the connection is an infrared receiver. Yamakita discloses a portable facsimile device (1, Figs.1-2) connected to network 3 by using scheme of transmitting/receiving data on a radio channel wherein the scheme has a communication function by using IR (infrared ray) communication (col. 4, lines 55-61). It would have been obvious to one skilled in the art at the time the invention was made to combine the above teaching of Yamakita to the system 140 in Kenmochi et al in view of Bowden to modify the connection between the fax printing device and the camera to be an infrared connection since Kenmochi et al also teaches different communication lines the system can be connected to different types of receivers without limiting the use of an infrared receiver.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Gerszberg et al (US Patent No. 6,396,531) discloses a system architecture for bypassing a local exchange carrier.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read "Madeleine AV Nguyen". The signature is fluid and cursive, with the first name "Madeleine" written in a stylized, connected script.

Madeleine AV Nguyen
Primary Examiner
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October 10, 2007